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Jordi Alborno

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW
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EXAMINER

PHAM, MICHAEL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/757,793	Applicant(s) ALBORNOZ ET AL.	
	Examiner MICHAEL PHAM	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 and 25-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Status

1. Claims 9-13 and 25-41 are pending.
2. Claims 9-13 and 25-41 have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Prior 101 rejection directed towards claims 9-13 are withdrawn.
5. Prior rejection directed towards claims 25-31 are withdrawn.
6. Claims 32-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims fail to place the invention squarely within one statutory class of invention. On page 6 paragraph 26 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include communication mediums such as wireless communications. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of Substances and therefor not a composition of matter.

Art Unit: 2167

7. Regarding claim 37, this claim recites a “processor” and “memory”. In the absence of any modifying disclosure of this limitation in the specification, the examiner interprets the term ‘processor’ as limited to hardware embodiments; and the term ‘memory’ as excluding printed paper, transmission media, signals, or any form of energy, such that the claim clearly falls within a statutory class of invention as required under the terms of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 9-13 and 25-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 20040252888 by Barger et. al. (hereafter Barger) further in view of U.S. Patent Application Publication 20040261016 by Glass et. al. (hereafter Glass).**

Claim 9:

Barger discloses the following claimed limitations “dictating how annotations made for a current versions of a document are applied, by operation of one or more computer processors, to a subsequent version of the document, wherein the subsequent version of the document

Art Unit: 2167

includes one or more revisions to substantive content of the current version of the document; and”[0013 lines 2-6, preserving the intent and meaning of digital ink annotations in an original document whenever the original document takes on a new layout as a result of being edited or displayed ion a different display device or in a different window size. 0014 lines 15-17, the reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified. Accordingly, dictating how (preserving the intent and meaning) annotations (annotation) made for a current versions of a document (0013, original document) are applied , by operation of one or more computer processors, to a subsequent version of the document(0014 line 17, digital document is modified), wherein the subsequent version of the document (0014, digital document is modified) includes one or more revisions to substantive content of the current version of the document (0013 line 3, edited; 0014 modified)]

“to dictate how the annotations are applied, by operation of one or more computer processors, to subsequent versions of the document”[0017, the annotation must logically be anchored to a region or position in the document where it belongs such that that same region or position in the document can be recovered even if the document’s layout, format, or content changes. The anchoring process defines anchoring rules for each classification of digital ink annotation, and applying these anchoring rules to each digital ink annotation and generates a logical anchor for each annotation. Accordingly, to dictate how (anchoring process) the annotations (annotations) are applied to subsequent versions of the document (document’s layout, format, or content changes)]

Art Unit: 2167

Bargerion does not explicitly disclose “selecting one or more annotation versioning policies” and “allowing creators for a current version of a document to select one or more annotation versioning policies”.

On the other hand, Glass discloses “selecting one or more annotation versioning policies”[figure 4] and “allowing creators for a current version of a document to select one or more annotation versioning policies”[figure 10]

Both Glass and Bargerion are directed towards annotation systems, and are therefore within applicant's same field of endeavor. Glass is directed to improving classification of a document based on sample documents and annotations, and further allowing for classification of documents by labeling the contents of the document based on human reasoning and document annotation policy. Glass further discloses providing a precise and consistent structure for annotating documents and portions of documents, abstract lines 3-6. Bargerion is directed to reflowing annotations to an edited document by logically anchoring an annotation to a region or position, and in doing so provides for classification of annotations in order to anchor the annotations. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have applied Glass's disclosure to the disclosure of Bargerion for the purpose easily selecting and controlling annotations that users are able to make thereby allowing for classification of documents.

Claim 10:

Art Unit: 2167

The combination of Barger and Glass disclose in Barger “wherein at least one of the annotation versioning policies dictates that annotations made for a current version will not be applied to subsequent versions of the document.” [0014, The clean up module is an optional component that can be used to eliminate the user’s original freehand annotations and redraw formalized cleaned-up versions of the annotations. Accordingly, wherein at least one of the annotation versioning policies dictates that annotations (original freehand annotations) made for a current version (original document) will not be applied (redraw) to subsequent versions of the document (cleaned-up version)]

Claim 11:

The combination of Barger and Glass disclose in Barger “the method of claim 9, wherein the one or more annotation versioning policies selected are applied at the document level, to all annotations created for a document.” [0014, The reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified. Accordingly, the method of claim 9, wherein the one or more annotation versioning policies selected (reflow) are applied at the document level (digital document is modified), to all annotations created for a document (original intent and meaning)].

Claim 12:

The combination of Barger and Glass disclose in Barger “the method of claim 9, wherein at least one of the annotation versioning policies dictates that an annotation created for a current version of a document will be applied to subsequent versions of the document.” [0014, The

Art Unit: 2167

reflow module insures preservation of the user's original intent and meaning whenever the digital document is modified.].

Claim 13:

The combination of Barger and Glass disclose in Glass “wherein at least one of the annotation versioning policies dictates an authorized user must validate an annotation created for a current version of a document before the annotation is applied to subsequent versions of the document” [See figure 7 element 224, figure 10, and paragraph 0134. Accordingly, wherein at least one of the annotation versioning policies dictates an authorized user (figure 7 element 224) must validate an annotation created for a current version of a document (figure 10) before the annotation is applied to subsequent versions of the document (0134, one version of a document to another).]

Claim 25:

Barger discloses “dictating how an annotation created for a current version of a document are applied , by operation of one or more computer processors, to one or more subsequent versions of the document, wherein each subsequent version of the document includes one or more versions to substantive content of the current version of the document; and” [Accordingly, dictating how an annotation created for a current version of a document (0013, preserving the intent and meaning of the digital ink annotation in an original document) are applied to one or more subsequent versions of the document (0014 line 17, digital document is

Art Unit: 2167

modified), wherein each subsequent version of the document includes one or more versions to substantive content of the current version of the document (0013 line 3 edited; 0014 modified)]

Bargerón does not explicitly disclose “defining a set of annotation policies, each” and providing an interface allowing a user to select one or more of the available annotation policies to be applied, by operation of one or more computer processors, to the annotation”

On the other hand, Glass discloses “defining a set of annotation policies, each” (figure 4) and “providing an interface allowing a user to select one or more of the available annotation policies” (figure 4) “to be applied to, by operation of one or more computer processors, to the annotation”(figure 10)

Both Glass and Bargerón are directed towards annotation systems, and are therefore within applicant's same field of endeavor. Glass is directed to improving classification of a document based on sample documents and annotations, and further allowing for classification of documents by labeling the contents of the document based on human reasoning and document annotation policy. Glass further discloses providing a precise and consistent structure for annotating documents and portions of documents, abstract lines 3-6. Bargerón is directed to reflowing annotations to an edited document by logically anchoring an annotation to a region or position, and in doing so provides for classification of annotations in order to anchor the annotations. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have applied Glass's disclosure to the disclosure of Bargerón for the

Art Unit: 2167

purpose easily selecting and controlling annotations that users are able to make thereby allowing for classification of documents.

Claim 26:

The combination of Barger and Glass disclose in Glass “the method of claim 25, wherein defining a set of available annotation policies comprises associating one or more annotation policies for use with annotations made for a certain type of document.” [figure 10, junk]

Claim 27:

The combination of Barger and Glass disclose in Glass “the method of claim 25, wherein the annotation policies provided to the user in the interface is determined, at least in part, on a credential of the user.” [figure 7 element 224, valid user].

Claim 28:

The combination of Barger and Glass disclose in “the method of claim 27, wherein the annotation policies provided to the user in the interface is determined, at least in part, on a type of document associated with the annotation.” [figure 10, junk].

Claim 29:

Art Unit: 2167

The combination of Barger and Glass disclose in “the method of claim 25, wherein defining a set of available annotation policies comprises defining the set of available annotation policies by an administrator, wherein the administrator and the user are different entities.” [0107, administrator].

Claim 30:

The combination of Barger and Glass disclose in Glass “wherein at least one of the annotation versioning policies dictates that an annotation created for a current version of a document and applied to a subsequent version of the document includes a marker indicating that the annotation in the subsequent version of the document is invalidated.” [figure 4, 10, 7. Accordingly, wherein at least one of the annotation versioning policies (figure 4) dictates that an annotation created for a current version of a document (document) and applied to a subsequent version of the document (0134, some of the full text 241 consists of personalizing content that may vary from one version of the document to another) includes a marker (figure 10, check) indicating that the annotation (figure 10, valid text) in the subsequent version of the document (0134, version) is invalidated (figure 10, unchecked, not valid text)]

Claim 31:

The combination of Barger and Glass disclose in Glass “The method of claim 30, wherein the marker is included in the annotation in the subsequent version of the document until an authorized user validates the annotation created for the current version of the document.” [figure 4, 10, 7. Accordingly, wherein the marker (figure 10, check) is included in the annotation (figure

Art Unit: 2167

10, valid text) in the subsequent version of the document (0134, version) until an authorized user validates (figure 7 element 224) the annotation created for the current version of the document (document)]

Claim 32:

Bargeron discloses the following claimed limitations “dictating how an annotation created for a current version of a document are applied, by operation of one or more computer processors, to one or more subsequent versions of the document, wherein each subsequent version of the document includes one or more revisions to substantive content of the current version of the document; and”[0013 lines 2-6, preserving the intent and meaning of digital ink annotations in an original document whenever the original document takes on a new layout as a result of being edited or displayed ion a different display device or in a different window size. 0014 lines 15-17, the reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified. Accordingly, dictating how (preserving the intent and meaning) annotations (annotation) created for a current version of a document (0013, original document) are applied , by operation of one or more computer processors, to a subsequent versions of the document(0014 line 17, digital document is modified), wherein the subsequent version of the document (0014, digital document is modified) includes one or more revisions to substantive content of the current version of the document (0013 line 3, edited; 0014 modified)]

Bargerion does not explicitly disclose “defining a set of available annotation policies, each” and “providing an interface allowing a user to select one or more of the available annotation policies to be applied, by operation of the one or more computer processors, to the annotation”.

On the other hand, Glass discloses disclose “defining a set of available annotation versioning policies, each”[figure 4] and “providing an interface allowing a user to select one or more of the available annotation policies to be applied,”[figure 4] “by operation of the one or more computer processors, to the annotation”[figure 10]

Both Glass and Bargerion are directed towards annotation systems, and are therefore within applicant's same field of endeavor. Glass is directed to improving classification of a document based on sample documents and annotations, and further allowing for classification of documents by labeling the contents of the document based on human reasoning and document annotation policy. Glass further discloses providing a precise and consistent structure for annotating documents and portions of documents, abstract lines 3-6. Bargerion is directed to reflowing annotations to an edited document by logically anchoring an annotation to a region or position, and in doing so provides for classification of annotations in order to anchor the annotations. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have applied Glass's disclosure to the disclosure of Bargerion for the purpose easily selecting and controlling annotations that users are able to make thereby allowing for classification of documents.

Claim 33:

The combination of Barger and Glass disclose in Glass “wherein defining a set of available annotation policies comprises associating one or more annotation policies for use with annotations made for a certain type of document.” [figure 10, junk]

Claim 34:

The combination of Barger and Glass disclose in Glass “wherein the annotation policies provided to the user in the interface is determined, at least in part, on a credential of the user.” [figure 7 element 224, valid user].

Claim 35:

The combination of Barger and Glass disclose in Glass “wherein the annotation policies provided to the user in the interface is determined, at least in part, on a type of document associated with the annotation.” [figure 10, junk].

Claim 36:

The combination of Barger and Glass disclose in “wherein defining a set of available annotation policies is defined based on user input from an administrator, wherein the administrator and the user are different entities.” [0107, administrator].

Art Unit: 2167

Claim 37:

Bargeron discloses the following claimed limitations:

“a computer processor; and”[figure 13]

a memory containing a program, which when executed by the computer processor is configured to perform an operation for compensating for managing annotations for multiple versions of documents, comprising:”[figure 13]

“dictating how an annotation created for a current version of a document are applied, by operation of one or more computer processors, to one or more subsequent versions of the document, wherein each subsequent version of the document includes one or more revisions to substantive content of the current version of the document; and”[0013 lines 2-6, preserving the intent and meaning of digital ink annotations in an original document whenever the original document takes on a new layout as a result of being edited or displayed ion a different display device or in a different window size. 0014 lines 15-17, the reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified.

Accordingly, dictating how (preserving the intent and meaning) annotations (annotation) created for a current version of a document (0013, original document) are applied , by operation of one or more computer processors, to a subsequent versions of the document(0014 line 17, digital document is modified), wherein the subsequent version of the document (0014, digital document is modified) includes one or more revisions to substantive content of the current version of the document (0013 line 3, edited; 0014 modified)]

Bargerion does not explicitly disclose “defining a set of available annotation policies, each” and “providing an interface allowing a user to select one or more of the available annotation policies to be applied, by operation of the one or more computer processors, to the annotation”.

On the other hand, Glass discloses disclose “defining a set of available annotation versioning policies, each”[figure 4] and “providing an interface allowing a user to select one or more of the available annotation policies to be applied,”[figure 4] “by operation of the one or more computer processors, to the annotation”[figure 10]

Both Glass and Bargerion are directed towards annotation systems, and are therefore within applicant's same field of endeavor. Glass is directed to improving classification of a document based on sample documents and annotations, and further allowing for classification of documents by labeling the contents of the document based on human reasoning and document annotation policy. Glass further discloses providing a precise and consistent structure for annotating documents and portions of documents, abstract lines 3-6. Bargerion is directed to reflowing annotations to an edited document by logically anchoring an annotation to a region or position, and in doing so provides for classification of annotations in order to anchor the annotations. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have applied Glass's disclosure to the disclosure of Bargerion for the purpose easily selecting and controlling annotations that users are able to make thereby allowing for classification of documents.

Claim 38:

The combination of Barger and Glass disclose in Glass “wherein defining a set of available annotation policies comprises associating one or more annotation policies for use with annotations made for a certain type of document.” [figure 10, junk]

Claim 39:

The combination of Barger and Glass disclose in Glass “wherein the annotation policies provided to the user in the interface is determined, at least in part, on a credential of the user.” [figure 7 element 224, valid user].

Claim 40:

The combination of Barger and Glass disclose in Glass “wherein the annotation policies provided to the user in the interface is determined, at least in part, on a type of document associated with the annotation.” [figure 10, junk].

Claim 41:

The combination of Barger and Glass disclose in “wherein defining a set of available annotation policies is defined based on user input from an administrator, wherein the administrator and the user are different entities.” [0107, administrator].

Response to Arguments

Art Unit: 2167

10. Applicant's arguments filed 5/20/09 have been fully considered but they are not persuasive.

Applicant's primarily assert the following in regards to cited references.

A. Applicant's assert that the cited references do not disclose "selecting one or more annotation versioning policies dictating how annotations made for a current version of a document are applied to a subsequent version of a document" because Glass does not disclose "annotation versioning policy" because it is a mere coincidence of terms. That even if assuming Glass disclosed the annotation policy that the annotation policy is merely used by a human individual to assist human individual in applying human reasoning. That Bargerion does not disclose annotation versioning policy either and that therefore Bargerion does not disclose the limitation.

In response, this is respectfully disagreed.

First, it is not a mere coincidence of terms. An administrator in Glass decides which policies to define, see figure 4. That these policies are applied in a plurality of documents, for example see figure 10 which illustrates a document being annotated with respect to the definition provided in figure 4. The documents are for "each of a series of collection of documents intended to serve as sample documents to be annotated are collected, parsed, and stored" (Glass,

Art Unit: 2167

0097 lines 4-6). Accordingly, Glass disclosed an annotation versioning policy because the annotation definition provided in Glass is applied to a series of collection of documents.

Secondly, in regards to that the annotation policy is only used to assist a human individual in applying human reasoning, this statement is incorrect. The annotation definition also allows for annotations to be consistent, abstract lines 3-6. The only thing that Glass did not disclose was that the “annotations made for a current version of a document are applied to subsequent versions of the document”, of which Bargerón disclosed, and of which applicants do not contend.

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the combination of Glass and Bargerón disclosed the limitation. Bargerón disclosed “annotations made for a current version of a document are applied to subsequent versions of the document” as detailed above in the rejection, and Glass disclosed “annotation versioning policy” as an annotation definition in order to issue annotations to a series of documents. The references are both within the same field of applicant's endeavor, and are therefore combinable.

For the above reasons, the rejections are maintained.

Conclusion

11. The prior art made of record listed on pto-892 and not relied, if any, upon is considered pertinent to applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PHAM whose telephone number is (571)272-3924. The examiner can normally be reached on 9am-5pm.

Art Unit: 2167

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P./
Examiner, Art Unit 2167

/John R. Cottingham/
Supervisory Patent Examiner, Art Unit
2167